

Remarks

By the above Amendments, the Applicant has replaced pending claims 16 through 33 with amended claims 16 through 33. Entry of these Amendments, reconsideration of the claims presented in this Office Action, and allowance of the claims now pending are respectfully requested. No new matter was introduced. Claims 16 through 33 are pending in this application.

Response to Comments in Office Action

In paragraphs 2 on pages 2 of the Action, the Patent Office rejected claim 28 under 35 USC 112, second paragraph, for being indefinite by not providing structural cooperation. The Applicant believes that the above Amendment to claim 28 overcomes these objections.

In paragraphs 3 and 4 on pages 2 and 3 of the Action, the Patent Office rejected claims 16-33 under 35 USC §103(a) as obvious in view of US patent 4,653,837 of Granger [herein "Granger '837"] and US patent 3,961,700 of Fleischauer [herein "Fleischauer"]. However, the Applicant again submits that this rejection is inappropriate, and requests that the Patent Office reconsider these rejections in view of the following.

The Present Invention has been Commercially Successful

Paper dispensers embodying aspects of the claimed invention have been commercialized globally. These dispensers are recognized in the industry as being superior to competing products.

The Applicant is Knowledgeable in the Art of the Invention

First, the sole inventor whose name appears on Granger '837 is the very same inventor whose name appears on the present application. Therefore, it is submitted that the applicant, Mr. Maurice Granger, is quite familiar with the art of Granger '837 and, in particular, the deficiencies of Granger '837.

Mr. Granger is an expert in the art of the present invention. Mr. Granger has over 30 years experience in the field of paper dispensers. Mr. Granger's name appears as an inventor on over forty (40) U.S. patents, see the list that appears in Appendix A of this submittal. On almost all of these U.S. patents, Mr. Granger's name appears as the sole inventor. Mr. Granger is extremely knowledgeable in this field.

In lines 13-15 on page 1 of the present specification, Mr. Granger identifies the prior art European Patent No. 145, 622 [herein "EP '622"] which was identified in the parent PCT Search Report and is of record in this application. Mr. Granger is also the sole inventor that appears on EP '622. Again, clearly, the Applicant is very familiar with the art of the present invention and may be considered an expert in his field.

On pages 2 and 3 of the present Specification, Mr. Granger discusses the deficiencies of the prior art as represented by EP '622. Though EP '622 does not correspond directly with Granger '837, the devices disclosed in EP '622 and in Granger '837 are sufficiently similar that the deficiencies of EP '622 discussed by Mr. Granger equally apply to the deficiencies of Granger '837. Specifically, as recognized by Mr. Granger and recited on pages 2 and 3 of the present application, EP '622 and Granger '837 have the following deficiencies:

Although these arrangements [of EP '622 and Granger '837] ensure satisfactory operation of the paper strip dispensing machine, there are still

nevertheless several drawbacks resulting from the way in which the strip of paper is fed and pulled through the outlet of the dispensing machine by the user.

In fact, the user often tends to pull the strip of paper to the right or left-hand side at a slant and this has the effect of causing the belt to escape from the above-mentioned grooves, thus impeding operation of the machine and sometimes jamming it if the paper tears.

Very often the belt even tends to jump out of the groove and this obviously has an adverse effect on the correct operation of the dispensing machine.

Because of these recognized deficiencies of the prior art, as represented by his own EP '622 and his own Granger '837, Mr. Granger attempted to overcome these drawbacks as described beginning on the top of page 3 of the present Specification:

The first solution tried to solve these drawbacks was to increase the tension of the belt in order to prevent it escaping from the groove by keeping it very tight. This first solution had a secondary disadvantage. It was apparent that it became hard to rotate the mechanism for starting the drum and difficulties were encountered in pulling the paper and strip of material in general, especially when the user's hands were wet.

Increasing the tension of the belt was therefore unsatisfactory and made it impossible to use the dispensing machine.

Another approach was to increase the diameter of the edges of the groove on the shaft so as to produce a kind of deep channel intended to prevent the part of the belt in question from escaping if the paper was pulled sideways.

This solution was not entirely satisfactory because, in practice, it became apparent that the middle of the paper was marked and very often split in two

pieces either side of the central area when it was cut.

After these two unsuccessful attempts to overcome the deficiencies of the prior art, on the bottom of page 3 of the present Specification, Mr. Granger proposes the solution for which protection is now sought. Only upon recognizing the problems inherent in the prior art mechanisms and after multiple attempts to remedy the problems in an art that Mr. Granger is intimately familiar with, did Mr. Granger conceive of and develop the present invention. The present invention has been in commercial use and has successfully overcome the deficiencies of the prior art. These deficiencies were only recognized by Mr. Granger. These deficiencies of the prior art were not recognized by of EP '622 and Granger '837 (nor clearly not by Fleischauer!). These deficiencies of the prior art are only recognized by Mr. Granger and were then successfully addressed only by the present invention.

Fleishauer is Not Analogous Art

With respect to the rejections of independent claims 16 and 31, in rejecting these claims, the Patent Office first recognizes the teachings that are missing from Granger '837, specifically, the relative dimensions of the central section of the claimed invention, and then states that such features are "old and well known in the art as evidenced by Fleischauer". However, first, the Applicant respectfully submits that Fleishauer is not "in the art" of the present invention. As discussed earlier in response to a 102 rejection based upon Fleishauer, the Applicant submits that Fleischauer is simply not analogous art.

Section 2141.01(a) of the MPEP provides the following guidelines concerning what can be considered analogous art when making a rejection pursuant to 35 USC §103(a):

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to

rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). [Emphasis added.]

The machine disclosed by Fleischauer is clearly not a "paper strip dispensing apparatus" as recited in claim 16 and disclosed in the present specification. As described in the Abstract of Fleischauer, the invention disclosed by Fleischauer is "a conveyor construction". Fleischauer is simply a "conveyor construction" driven by multiple belts or "o-rings". The conveyor of Fleischauer clearly does not and could not dispense paper strips, for example, paper towels, toilet paper, and the like, as claimed and described in the present application. The Applicant respectfully submits that Fleischauer is not "in the field of applicant's endeavor".

Moreover, the Applicant submits that Fleischauer is not "reasonably pertinent to the particular problem." As discussed above, Mr. Granger – and only Mr. Granger – recognized a problem in the prior art. Specifically, the problem is created by the user of such devices pulling the paper strip to the right or left when dispensing paper strips. Not only is Fleischauer not analogous art, but also Fleischauer teaches nothing whatsoever concerning addressing the problem of a user pulling a strip of paper to the left or right. This is quite understandable since Fleischauer does not disclose any kind of strip material dispensed over a shaft that would have such a deficiency when the paper is pulled laterally to the left or right as in the present invention. There is no disclosure or suggestion whatsoever in Fleischauer that either shaft of Fleischauer is laterally loaded in anyway. Lacking any disclosure or suggestion whatsoever that the belt/shaft configuration of Fleischauer in anyway addresses a problem with lateral loading on a

shaft, Fleishauer therefore does not and cannot disclose or suggest any type of strip material dispensing in a lateral direction that "logically would have commended itself to an inventor's attention in considering his problem." The Applicant submits that for these reasons alone, these rejections are inappropriate and should be reconsidered

There is No Teaching to Combine the Art

In addition, the Applicant submits that there is no teaching, suggestion, or motivation presented in the cited art to combine the teachings of Granger '837 and Fleischauer. Section 2143.10 of the MPEP provides the following guidelines concerning the appropriateness of combining the teachings of prior art references:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) [Emphasis added.]

The Applicant submits that neither Granger '837 nor Fleischauer provide any teaching, suggestion, or motivation to combine their teachings to produce the present invention. In addition, the Applicant submits that the nature of the problem to be solved "as a whole" by the present invention does not suggest that the teachings of Granger '837 and Fleischauer be combined.

Again, as noted above, Granger '837 does not recognize that the problem addressed by the present invention – that is, the lateral pulling of the paper strips by the user – exists, therefore Granger '837 does not and cannot provide any teaching, suggestion, or motivation to address this problem. Also, as noted above, Fleishauer is not even analogous art, does not recognize the problem addressed by the present

invention, and also does not provide any teaching, suggestion, or motivation to address this problem.

With regard to "the nature of the problem to be solved as a whole", the CPPA has addressed this issue at least twice. Specifically, in *In re Nomiya* the CPPA held:

It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103. *In re Nomiya*, 184 USPQ 607, 612 (C.C.P.A. 1975) [Emphasis added]

In *In re Bisley*, the CPPA held:

Moreover, the conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. . . . The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem; and though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negative invention. *In re Bisley*, 94 USPQ 80, 86-87 (C.C.P.A. 1952) [Emphasis added]

Thus, the Applicant submits that the rejections of claims 16 and 31 under 35 USC §103(a) as obvious in view of Granger '837 and Fleischauer are inappropriate. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Even if Combined the Claimed Invention Does not Ensur

Moreover, even if it were proper to combine the teachings of Granger '837 and Fleischauer (which it is not), the claimed invention would not ensue. The Applicant has already discussed the invention of Granger '837 above, and its deficiencies. The Patent Office proposes that the invention of Granger '837 can be combined with the invention of Fleischauer to yield the present invention. A closer examination of

Fleischauer is therefore warranted.

As discussed above, Fleischauer discloses "a conveyor construction" driven by multiple belts or "o-rings" on two perpendicular shafts. Since the shafts of Fleischauer which are coupled by o-rings are oriented perpendicular to each other and the shafts (that is, the drum 4 and shaft 9) of the present invention coupled by belt 10 are parallel to each other, it is unclear to the Applicant how the perpendicular shafts of Fleischauer can be incorporated into the housing of Granger '837, that is, without some re-engineering guidance (which neither reference provides) and provide the intended operation of the present invention. Nowhere in Fleischauer is it disclosed or suggested that the shafts of Fleischauer can or should be oriented parallel to each other as in the present invention.

The Patent Office's position that "such a shaft configuration is old and well known in the art" is not an appropriate basis upon which to reject the present claims and is flies in the face of the established law, as discussed above. The references combined to make this rejection:

- 1) are not analogous art, since they are neither both "in the field of applicant's endeavor " nor "logically would [Fleishauer] have commended itself to an inventor's attention in considering his problem";
- 2) do not provide any teaching, suggestion, or motivation to combine their teachings;
- 3) do not recognize the nature of the problem to be solved; and
- 4) even when combined, do nor provide the claimed invention.

For these reasons, the Applicant submits that the rejections of claims 16 and 31 as obvious in view of Granger '837 and Fleishauer are inappropriate. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

The Dependent Claims are Also Non-obvious

First, the Applicant submits that that the rejections of claims 17-30, 32 and 33 as obvious in view of Granger '837 and Fleischauer are inappropriate for the same reasons that the rejections of claims 16 and 31 were inappropriate, as discussed above. In addition, certain features of the dependent claims are clearly not disclosed, taught, or suggested by Granger '837 and Fleischauer. For example, nowhere in Granger '837 and Fleischauer is a shaft with central section comprising "shoulders adapted to prevent the lateral movement of the at least one belt" as recited in claims 18 and 19 taught or suggested. None of the shafts of Granger '837 and Fleischauer include shoulders as claimed, or provide any teaching or motivation to provide such shoulders.

Conclusions

The Applicant submits that the rejections of claims 16-33 as obvious in view of Granger '837 and Fleishauer are inappropriate.

The Applicant believes that the application is in allowable form. Passage of the application to issue is earnestly solicited. Should any matters remain outstanding, it is requested that the undersigned Agent be given a call so that such matters may be worked out and the application placed in condition for allowance without the necessity of another Action.

Request for Interview

Again, if the Patent Office is still of the opinion that the subject matter of the pending claims does not constitute patentable subject matter, the Applicant requests an interview with the Examiner pursuant to section 706.07(b) of the MPEP.

Respectfully submitted,


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Appendix A

U.S. Patents of Maurice Granger
Related to Paper Dispensers

No.	U.S. Patent No.	Title
1	6,609,450	Automatic dispensing apparatus for paper towels and toilet paper
2	6,609,449	Automatic dispensing apparatus for paper towels and toilet paper
3	6,561,598	Loading device for wipe material dispensing machine
4	6,550,714	Wiping material dispensing apparatus
5	6,497,167	Wiping material dispensing drum in dispensing apparatus with format and length adjustment of the dispensed material
6	6,474,591	Device for inserting a material strip in wiping material dispensing apparatus
7	6,474,209	Automatic or semi automatic wiping material and toilet paper dispenser
8	6,457,394	Wiping material and toilet paper dispensing apparatus with automatic or semiautomatic functioning
9	6,450,076	Folded/unfolded paper towel dispensing apparatus
10	6,443,043	Automatic dispensing apparatus for paper towels and toilet paper
11	6,416,011	Dispensing machine for wipe material with the reel in a frontal position
12	6,415,948	Device for controlling and limiting the drum rotation in a wiping material dispenser
13	6,378,725	Automatic or semiautomatic wiping material and toilet paper dispensing apparatus
14	6,363,824	Paper-wipe dispensing machine
15	6,196,102	Device for controlling the rotation of a support drum in a paper dispensing apparatus
16	6,179,243	Apparatus dispensing unfolded wiping material
17	6,092,451	Automatic or semi-automatic dispensing machine for wipe material with selector device
18	6,027,002	Paper towelling dispenser with spare roll loading device
19	6,006,642	Dispensing machine for strips of coiled wadding material using automatic or semi-automatic traction with spare roll
20	5,979,284	Automatic dispensing apparatus for paper towels and toilet paper
21	5,937,718	Folded/unfolded paper towel dispensing apparatus
22	5,915,645	Loading device for dispensing apparatus for material wipes
23	5,868,343	Folded/unfolded paper towel dispensing apparatus
24	5,836,862	Folded and unfolded paper towel dispensing apparatus

25	5,207,633	Apparatus to dispense discrete portions of corrugated wiping materials
26	5,147,279	Device destined to automatically dispense wiping materials of a concertina form consisting of rolled up strips
27	5,146,830	Unit to simultaneously dispense and cut strips of rolled up materials
28	5,135,147	Dispenser for cutting wiping materials stored in a unit and dispenses a narrow, concertina type folded strip
29	5,108,357	Device for dispensing folded cut wiping material
30	5,065,924	Paper towel dispenser with central unwinding
31	5,054,706	Device to adjust and dispense webs of rolled up material
32	5,013,291	Device destined to automatically dispense wiping materials of a concertina form consisting of rolled up strips
33	4,846,035	Perfected cutting device for a device for dispensing and simultaneous cutting of material rolled up in webs
34	4,844,361	Device for dispensing webs of material rolled up on a core with automatic device for replacing the roll in use by a stand-by roll
35	4,648,530	Automatic dispenser of pre-cut and Z-wrapped or folded web materials
36	4,635,837	Means for distribution and simultaneously cutting bands of rolled material with at least one roll of material in use
37	4,621,755	Device for dispensing and simultaneously cutting rolled up materials in webs
38	4,552,315	Rolled web dispenser
39	4,213,363	Apparatus for the cutting and simultaneous dispensing of a web of roll material
40	4,122,738	Apparatus for the cutting and simultaneous dispensing of a web of roll material
41	3,998,120	Apparatus for the simultaneous distribution and cutting of strips of rolled materials
42	3,996,828	Device for cutting longitudinal strips from reels of materials in strip or foil or sheet or similar form or of reduced thickness
43	3,981,215	Apparatus for cutting sheet material